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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/720,494
Filing Date: November 24, 2003
Appellant(s): TREMBLAY, MICHAEL A.

Michael A. Papalas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on August 22, 2005 appealing from the

Office action mailed on November 10, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings, which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,339,436   AMRO et al.   01-2002

5,991,756   WU   11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 24, 25 and 26 are rejected under 35 U.S.C. 102(e) and Claim 2 is

rejected under 35 U.S.C. 103(a) and Claims 3 – 6 are rejected under 35 U.S.C. 103(a)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 24, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated

by U.S. Patent Number 6,339,436 issued to Hatim Amro et al. ("Amro").

With respect to claim 1, Amro teaches providing assistance to a user (column 1,

line 42 – 44), comprising:

monitoring user events (column 1, lines 44 – 46);

determining whether a series of user events is unrelated (column 1, lines 50 –

52); and

offering assistance to a user, wherein said offering assistance is operable upon

determination by said determining that said series of user events is unrelated (column 1,

lines 46 – 55).

As to claim 24, analyze a timing relationship between events in said series

(column 2, line 59 – column 3, line 13).

As to claim 25, determine whether a plurality of menus is accessed by said user

without invoking a program action associated with said plurality of menus (column 4,

lines 1 – 15).

As to claim 26, emptying an event queue of said plurality of user events when

said code for determining determines said plurality of user events are related (column 3,

lines (column 3, lines 30 – 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amro.

As to claim 2, Amro teaches all the steps to provide assistance to a user,

however, Amro does not explicitly discloses executable instructions are operable to

execute as a modification to an operating system as claimed. Amro discloses a method

and system of providing monitoring program which runs synchronized with the

application but in the background. When the application running with the monitoring

program . . . as part of the application (column 2, lines 27 – 32).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was to modify "executable instructions are operable to execute as

a modification to an operating system" as disclosed by Amro. This modification would

have been allowed the teaching of Amro to provide user-defined dynamic help text

which is displayed integrally with the application (column 1, lines 42 – 44).

Claims 3 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Amro as applied to claim 1 above, and further in view of U.S. Patent Number 5,991,756

issued to Jiong Wu ("Wu").

As to claim 3, Amro teaches all of the above limitations except that he does not

explicitly teach the steps of prompting a user for search terms and conducting a

hierarchical search utilizing said search terms as claimed.

Wu discloses claimed user search terms and conducting a hierarchical search

utilizing said search terms (column 2, lines 48 – 57, column 3, lines 50 – 53 and column

6, lines 13 – 30 and 53 - 55; Wu).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was to combine the teaching of Wu with the teaching of Amro, because

combination would provide for efficient storage of hierarchical data while allowing

searches to be performed taking into account relationships among data elements in a

hierarchy (column 2, lines 60 – 63; Wu).

As to claim 4, conducting is operable to search user websites when information is

not obtained locally on a system executing said conducting (column 4, lines 16 – 20,

lines 40 – 48 and column 12, lines 56 – 58; Wu).

As to claim 5, presenting search results to a user (column 3, lines 26 – 31; Wu).

As to claim 6, receiving user input selecting a search result of said search

results; and designating said selected search result in a user profile stored locally on

said system executing said conducting (column 6, lines 53 – 62; Wu).

Claims 8 – 14 and 27 – 29 are essentially the same as claims 1 – 6 and 24 – 26

above except that it set forth the claimed invention as a method rather than a computer

readable medium and rejected for the same reasons as applied hereinabove.

Claims 17 – 19 and 30 – 31 are essentially the same as claims 1 – 6 and 24 – 26

above except that it set forth the claimed invention as a system rather than a computer

readable medium and rejected for the same reasons as applied hereinabove.

(10) Response to Argument

Appellant's arguments regarding the rejection of claims 1 – 6, 8 – 14, 17 –18 and

24 – 31:

Argument No. 1: Appellant argues that Amro reference does not anticipate claim

language (Page 5, The Second Paragraph, Brief).

Argument No. 2: Amro does not determine whether a series of events is "unrelated" (Page 6, The Second Paragraph, Brief).

Argument No. 3: Amro does not offer assistance when a series of events is "unrelated" (Page 6, The Fifth Paragraph, Brief).

Argument No. 4: Amro makes no mention of any timing relationship (Page 8, The First Paragraph, Brief).

Argument No. 5: Amro fails to disclose "determining whether said user generates a plurality of operating system events without invoking program tasks" (Page 8, The Sixth Paragraph, Brief).

Argument No. 6: Appellant submits that sufficient motivation to combine has not been established (Page 10, The Third Paragraph, Brief).

Argument No. 7: A *prima facie* case of obviousness has not been established (Page 10, The Second Paragraph, Brief).

Argument No. 8: Wu does not cure deficiencies in Amro, since Wu fails to teach or suggest the recited limitation. Wu is not concerned with events occurring on the user's system. Wu does not offer assistance upon determining that the series is "unrelated" (Page 10, The First Paragraph, Brief).

Examiner's Response to Arguments:

In response to Argument No. 1:

In response to Applicants' argument that Amro does not disclose claimed limitations in the cited section (cited location has nothing to do with applicant's invention). Examiner likes to point out that in the "Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002) Decided August 8, 2002."

In the above case it is concluded that the prior art **disclosure need not be express in order to anticipate**. Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art**. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest

reasonable interpretation consistent with the specification." Applicant always has the

opportunity to amend the claims during prosecution, and broad interpretation by the

examiner reduces the possibility that the claim, once issued, will be interpreted more

broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51

(CCPA 1969). The court found that applicant was advocating ... the impermissible

importation of subject matter from the specification into the claim.). See also In re

Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court

held that the PTO is not required, in the course of prosecution, to interpret claims in

applications in the same manner as a court would interpret claims in an infringement

suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest

reasonable meaning of the words in their ordinary usage as they would be understood

by one of ordinary skill in the art, taking into account whatever enlightenment by way of

definitions or otherwise that may be afforded by the written description contained in

applicant's specification.").

The broadest reasonable interpretation of the claims must also be consistent with

the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d

1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

In response to Argument No. 2:

In response to Applicants' argument, Amro determines if the current event of the

plurality of events is a user event and Amro also determines if the current event is not a

spy event. If the current event is a user event, then the help text corresponding to the

current event of the plurality of events is updated according to a user text update.

Amro's method uses a monitoring program which allows users to create customized

help texts for any application. If the event is neither a spy event nor a user event, then it

is another type of GUI event (unrelated event) and the monitoring program handles it

accordingly, via step 218.

In response to Argument No. 3:

In response to Applicants' argument, Amro's teachings of utilizing a monitoring

program to monitor a plurality of events for the application; determining if a current

event of the plurality of events is a spy event (other than user event); if the current event

of the plurality of events is a spy event (other than user event), then <u>displaying a help</u>

<u>text corresponding to the current event of the plurality of events</u>. Again Amro

determines if the current event of the plurality of events is a user event if the current

event is not a spy event. If the current event is a user event, then the help text

corresponding to the current event of the plurality of events is updated according to a

user text update. Amro's method uses a monitoring program which allows users to

create customized help texts for any application. If the event is neither a spy event nor

a user event, then it is another type of GUI event and the monitoring program handles it

accordingly, via step 218. The monitoring program then loops back to the beginning of

the event handling loop to await the next event. This continues until the monitoring

program is terminated. As disclosed above, Amro clearly teaches plurality or multiple or

series of events and clearly teaches monitoring events and since Amro's teachings

compare to show that a series of events are related or unrelated, Amro's teaching

clearly teaches Applicant's claim language.

In response to Argument No. 4:

In response to Applicants' argument, Amro teaching of monitoring program which

loops back to the beginning of the event (starting time) handling loop to await the next

event (timewise). This continues until the monitoring program is terminated (ending

time). Amro's teaching of the beginning of the event handling loop to await the next

event and continued until terminated teaches Applicant's claimed timing relationship.

In response to Argument No. 5:

In response to Applicants' argument, Amro teaches User One 302 clicks the right

mouse button inside the window. The monitoring program 310 recognizes this as a

user event, via step 204. Another search of the user-defined dynamic help text file 314

for corresponding help text for the opened file screen, via step 206. Since no help text

exists for this new screen, an empty help text window is continued to be displayed.

Since the event is a user event, via step 212, the monitoring program then gets User

One's inputs for this new screen via step 214, such as "Input transaction number . . . ".

The monitoring program 310 stores it in the user-defined dynamic help text file 314, via

step 216. User One 302 repeats the above steps until the entire accounting function

has been performed. The result is a   user-defined dynamic help text file 314 with

help texts corresponding to various events for the application 306 which will guide User

Two 304 through the entire accounting calculation. Amro's teaching of User One 302

clicks the right mouse button inside the window teaches applicant's claimed limitation.

In response to Argument No. 6:

In response to Applicants' argument, to combine the references, the examiner

recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be

bodily incorporated into primary reference's structure, nor whether claimed invention is

expressly suggested in any one or all of references; rather, test is what combined

teachings of references would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in

single invention may come from references themselves, from knowledge of those skilled

in art that certain references or disclosures in references are known to be of interest in

particular field, or from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great

Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided

February 7, 1996 Nos. 95-1171, -1181

"[q]uestion is whether there is something in prior art as whole to suggest

desirability, and thus obviousness, of making combination." Lindemann Maschinenfabrik

GMBH v. American Hoist and Derrick Company et al. U.S. Court of Appeals Federal

Circuit 221 USPQ 481 Decided Mar. 21, 1984 No 83-1178.

In response to Argument No. 7:

In response to Applicants' argument, a prima facie case of obviousness is

established when the teachings from the prior art itself would appear to have suggested

the claimed subject matter to a person of ordinary skill in the art. Once such a case is

established, it is incumbent upon appellant to go forward with objective evidence of

unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

In response to Argument No. 8:

In response to applicant's argument that Wu does not teach or suggest

monitoring multiple events and determining whether a series of the events is unrelated

and that Wu do not have any connection to events occurring on the user's system, the

fact that applicant has recognized another advantage which would flow naturally from

following the suggestion of the prior art cannot be the basis for patentability when the

differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd.

Pat. App. & Inter. 1985).

Examiner uses Wu reference because Wu discloses the steps of prompting a

user for search terms and conducting a hierarchical search utilizing search terms

(column 2, lines 48 – 57, column 3, lines 50 – 53 and column 6, lines 13 – 30 and 53 -

55; Wu). Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was to combine the teaching of Wu with the teaching of Amro,

because combination would provide for efficient storage of hierarchical data while

allowing searches to be performed taking into account relationships among data

elements in a hierarchy (column 2, lines 60 – 63; Wu).

In response to applicant's argument that Amro does not monitor multiple events

and determine whether a series of the events is unrelated, Amro's teachings of utilizing

a monitoring program to monitor a plurality of events for the application; determining if a

current event of the plurality of events is a spy event; if the current event of the plurality

of events is a spy event, then displaying a help text corresponding to the current event

of the plurality of events. Again Amro determines if the current event of the plurality of

events is a user event if the current event is not a spy event. If the current event is a

user event, then the help text corresponding to the current event of the plurality of

events is updated according to a user text update. Amro's method uses a monitoring

program which allows users to create customized help texts for any application. If the

event is neither a spy event nor a user event, then it is another type of GUI event and

the monitoring program handles it accordingly, via step 218. The monitoring program

then loops back to the beginning of the event handling loop to await the next event.

This continues until the monitoring program is terminated. As disclosed above, Amro

clearly teaches plurality or multiple or series of events and clearly teaches monitoring

events and since Amro's teachings compare to show that a series of events are related

or unrelated, Amro's teaching clearly teaches Applicant's claim language.

        For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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